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In re Application of: Lee A. Burton
Application No. 10/618,041
Attorney Docket No. SRC027
Filed: July 11, 2003
For: SWITCH/NETWORK ADAPTER PORT
INCORPORATING SHARED MEMORY
RESOURCES SELECTIVELY ACCESSIBLE
BY A DIRECT EXECUTION LOGIC
ELEMENT AND ONE OR MORE DENSE
LOGIC DEVICES

**DECISION ON PETITION
UNDER 37 C.F.R. 1.103(a) FOR
SUSPENSION OF EXAMINATION**

This paper provides the decision on the petition filed on December 27, 2006, under 37 C.F.R. § 1.103(a) for suspension of examination for a period of 6 months.

The Petition is **GRANTED**.

Applicable Prosecution History

Jun 01, 2006	Final Rejection mailed
Jul 21, 2006	After Final Amendment filed by applicant
Aug 04, 2006	Advisory action mailed; After Final Amendment was refused entry
Sep 29, 2006	Request Continue Examination filed, seeking to enter the After Final Amendment with the RCE, and also with a request to suspend examination for 3 months. After Final Amendment was entered with the filing of the RCE.
Dec 14, 2006	Non-Final action was mailed in response to the RCE
Dec 29, 2006	Instant Petition filed, requesting that examination of application

be suspended in accordance with 37 CFR§1.103(a) for a period of 6 months.

RELIEF REQUESTED

The Applicant respectfully requests that examination of U.S. Patent Application No.: 10/618,041 (instant application) be suspended in accordance with 37 CFR §1.103(a) for a period of 6 months.

OPINION

Petitioner asserts that instant application is a continuation-in-part to U.S. Patent Application No. 09/932,330 ("the '330 application"). Both the instant application and the '330 application were rejected as being obvious under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,052,134 by Foster ("Foster") in view of U.S. Patent No. 4,972,457 by O'Sullivan ("O'Sullivan") under a similar analysis, and several of the issues, as identified in the prosecution of the '330 application, with respect to the patentability of '330 application are currently under appeal before the Board of Appeals and Interferences at the USPTO. Petitioner also asserts that common ground exists in the interpretation of Foster and O'Sullivan with respect to the patentability of both applications, and it is likely, according to the Petitioner that the resolution of the issues before the Board of Appeals with respect to the '330 application will have a direct bearing on the future prosecution of the instant application.

Petitioner asserts that there are currently no outstanding office actions for the instant application.

ANALYSIS

37 CFR 1.103. Suspension of action by the Office.

(c) Limited suspension of action after a request for continued application (RCE) under § 1.114 . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

MPEP 709 states in part:

B. Request for Suspension Under 37 CFR 1.103(b) or (c)

1. Requirements

The Office will not grant the requested suspension of action unless the following requirements are met:

(A) the request must be filed with the filing of a design CPA or an RCE (applicants may use the check box provided on the transmittal form PTO/SB/29 or

PTO/SB/30, or submit the request on a separate paper);

(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, i.e., the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension cannot substitute for the submission;

(B) the request should specify the period of suspension in a whole number of months (maximum of 3 months). If the request specifies no period of suspension or a period of suspension that exceeds 3 months, the Office will assume that a 3-month suspension is requested; and

(C) the request must include the processing fee set forth in 37 CFR 1.17(i).

A careful review of the prosecution history, and the applicable papers, it is clear that the RCE was properly filed. A request for suspension of examination of instant application was filed with the filing of the RCE by checking the appropriate box on the transmittal form PTO/SB/30, and included the fee as set forth in 37 CFR 1.17(i). Hence the Request for Suspension of Examination of the instant application under 37 CFR 1.103(c) with the filing of the RCE was proper, and hence applicant was entitled to suspension of action for 3 months starting on 9/29/06 and ending on 12/29/2006.

Office issued an non-final office action on 12/14 2006. Since this office action was generated while the application was still in "suspension" status, the office action mailed 12/14/2006 is hereby vacated.

Applicant filed the instant petition on 12/27/2006 37 CFR 1.103(a), (while the application was still under suspension of examination 37 CFR 1.103(c)), to have the examination of application suspended for a period of 6 months.

37 CFR 1.103 States as follows:

37 CFR 1.103. Suspension of action by the Office.

(a) Suspension for cause . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

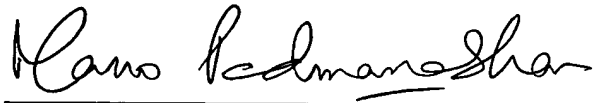
(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

A review of the prosecution history reveals that an office action is outstanding. However, as explained above, the office action was generated on 12/14/2006, during the period between 9/29/2006 and 12/29/2006, when the application was suspended from examination, and hence that office action has been vacated as noted above. Therefore, there are no outstanding office actions in this case. Therefore, the petition satisfies the requirement of 37 CFR 1.103(a) as outlined above.

Application SN10/618,041
Decision on Petition

Accordingly, the petition is **GRANTED**.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-4210.

A handwritten signature in black ink, reading "Mano Padmanabhan". The signature is fluid and cursive, with the first name "Mano" and last name "Padmanabhan" clearly distinguishable. A horizontal line is drawn beneath the signature.

Mano Padmanabhan
Quality Assurance Specialist,
Technology Center 2100, Work Group 2180